

REMARKS / ARGUMENTS

Pending claims 1-4 and 6-23 in the application stand rejected. By the foregoing amendment, the applicants have amended claims 1, 15, 16 and 20. No new matter is added by the amendments. In view of the foregoing amendments and following discussion, the applicants submit that all pending claims are in condition for allowance.

At page 2, paragraph 2 of the Office Action the Examiner rejected claims 1-4 and 6-23 under 35 U.S.C. 112, first paragraph, as not being enabled for any cancer or tumor other than those mediated by cytokines. The applicants respectfully traverse in part. By the foregoing amendments to claims 1, 15, 16 and 20, the applicants have overcome the rejections. Regarding claim 22 the amount of experimentation to practice the full scope of the claim is routine because the skill of the art is high and the techniques necessary to test the anti-proliferative effects of the claimed compounds on plasma cell dyscrasias are well known to those skilled in the art. Claims 2-4, 6-14, 17-19, 21 and 23 which depend from claims 1, 16, 20 or 22 and recite additional limitations thereon are also allowable. Accordingly, the applicants respectfully request the Examiner to withdraw the rejections.

At page 6, paragraph 3 of the Office Action the Examiner rejected claims 1-4 and 6-23 under 35 U.S.C. 103(a) as being unpatentable over Kapadia et al. (U.S. Patent No. 6,492,529) (hereinafter "Kapadia et al.") in view of Hanna (U.S. Application No. 2002/0012665) (hereinafter, "Hanna"). The applicants respectfully traverse the rejection. The current U.S. Application No. 10/761,913 ("913 application") and Kapadia et al. were, at the time the current invention was made, owned by Boehringer-Ingelheim Corporation. Thus, Kapadia is not available as a reference under 35 U.S.C. §103(a) and claims 1, 16, 20 and 22 are allowable. Claims 2-4 and 6-15, 17-19, 21 and 23 which depend from claims 1, 16, 20 or 22 and recite additional limitations thereon are also allowable. Accordingly, the applicants respectfully request the Examiner to withdraw the rejections.

At page 8, paragraph 4 of the Office Action, the Examiner rejected claims 1, 20 and 22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14 and 16 of Cirillo et al. (U.S. Patent No. 6,319,921), over claims 11 and 13 of Cirillo et al. (U.S. Patent No. 6,329,415), over claims 23-25 of Breitfelder et al. (U.S. Patent No. 6,358,945), over claims 12, 14 and 16 of Regan (U.S. Patent No. 6,372,773) and over claim 19 of

Cirillo et al. (U.S. Patent No. 6,825,184) in view of Kapadia et al. and Hanna. Enclosed herewith are suitable terminal disclaimers overcoming the rejections. Applicants request the rejections be withdrawn.

At page 10, paragraph 5 of the Office Action, the Examiner rejected claims 1, 12-14, 16 and 20-23 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5-6 of Cirillo et al. (U.S. Patent No. 6,333,325), over claims 3 and 5 of Cirillo et al. (U.S. Patent No. 6,525,046) and over claims 1, 11-13 and 17 of Moss et al. (U.S. Patent No. 6,916,814 but misstated by Examiner as U.S. Patent No. 6,825,184) in view of Kapadia et al. and Hanna. Enclosed herewith are suitable terminal disclaimers overcoming the rejections. Applicants request the rejections be withdrawn.

Applicants submit that all claims pending in the patent application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issuance are earnestly solicited. The fees for eight terminal disclaimers are included herewith. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

Respectfully submitted,

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